

35 U.S.C. § 103(a) rejection

Claims 2-9 and 12 remain rejected by the examiner as being obvious over Patel et al. (U.S. Patent 5,385,783) in view of Sakamoto et al. (U.S. Patent 5,683,806) and Leeuwenburgh (U.S. Patent 5,935,669).

The applicants response of 30 July 2002 are to be considered repeated here. However, the applicants would also like to address the examiner's "Response to Arguments" made in his final rejection. The examiner's response is primarily directed toward differences (5) and (6) referred to by the applicants in the response of 30 July 2002.

Difference (5)

With regard to difference (5), the examiner wrote "Applicant argues the 'adhesive contacts the primer' and not the paper support. This is not true because the Patel reference does teach this limitation of the adhesive contacting the primer in col. 1, lines 46-50, stating, the invention provides a high temperature resistant masking tape comprising a) a paper substrate, b) an impregnant in said paper substrate, c) a release coat on one surface of said paper, and d) an adhesive on the other surface of the paper."

Based on the examiner's arguments, it appears that the examiner has conceded that primary embodiments of Patel et al. invention do not have a contact adhesive coated onto one side of a paper support (see e.g. the Abstract, col. 1 and claim 1 of Patel et al.). However, while a reference can be relied upon for all that it teaches, it is also noted that the examiner is now relying upon a very narrow teaching within the Patel et al. reference which is not representative of Patel et al.'s invention when taken as a whole.

Difference (6)

With regard to difference (6), the applicants believe the examiner's position is incorrect for the following reasons.

- (1) As Patel et al. is the primary reference, there must be some reason or motivation to modify their teachings in order to arrive at the applicants' claimed invention. As stated above, in order for the examiner to establish a basis for his arguments, all the preferred teachings of Patel et al. must be ignored in favor of a more obscure embodiment of their invention. Even this more obscure embodiment still has a release coat attached to one side of their adhesive. When rolled, the release coat serves to protect both sides of the adhesive layer (see diagram of Patel et al's product below:)

Interior of roll of tape

64 – adhesive layer #1
58 – impregnated paper #1
60 – release coat #1
64 – adhesive layer #2
58 – impregnated paper #2
60 – release coat #2
64 – adhesive layer #3
58 – impregnated paper #3
60 – release coat #3

Exterior of roll of tape

As such, there is no need (and hence, no motivation) to substitute an additional cover layer onto the adhesive layer of Patel et al.; an advantage Patel et al. themselves acknowledge (see col. 2, lines 31-34).

- (2) Furthermore, it is unclear that either Sakumoto et al. or Leeuwenburgh teach the masking paper or masking film as asserted by the examiner (at best, it appears that there may be a broad teaching of use of a single cover layer, not the masking paper **AND** masking film **AND** their claimed properties as used by the applicants). However, there is no teaching or suggestion of having a masking paper and a masking film as in limitations (b) and (c) of the applicants' claim 12, i.e. even if it were permissible to pick and choose elements out of the teachings of Sakumoto et al. and Leeuwenburgh and substitute them into Patel et al., one of ordinary skill in the art would still not obtain the applicants' claimed invention.

Combination of Patel et al. in view of Sakamoto et al. and Leeuwenburgh even without differences (5) and (6) would not render applicants' claimed invention to be obvious

With regard to the examiner's proposed combination of Patel et al. in view of Sakamoto et al. and Leeuwenburgh as recited in the examiner's first office action, the examiner wrote that "Applicant fails to address **why the combined references cannot teach these functions and components.**" While the applicants believe that Patel et al. contains additional differences which are not addressed by the examiner's combination of references, the examiner's comments on the use of Patel et al., Sakamoto et al. and Leeuwenburgh suggests a "can be combined" rationale for the use of cited references.

However, this is not the proper standard for establishing a *prima facie* case for obviousness. MPEP 2143.01 states that "The mere fact that references can be combined or modified does not render the resultant combination obvious **unless the prior art also suggests the desirability of the combination.**" see also *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430, (Fed. Cir. 1990). The examiner's motivation for combining these references does not come from the prior art but a selective reading of the references which does not consider each of the inventions as a whole (see MPEP 2141.02).

Expanding upon a previous argument about the impermissibility of "picking and choosing" from the references, it is further noted that "...'**Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention.**'" see *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998).

There must be a teaching or suggestion within the prior art, within the nature of the problem to be solved, or within the general knowledge of a person or ordinary skill in the field of invention, to look to particular sources, to select particular elements, and to combine them as combined by the inventor. see *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 665, 57 USPQ2d 1161, 1167 (Fed. Cir. 2000); *ATD Corp.*, 159 F.3d 546, 48 USPQ2d 1329; *Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc.*, 21 F.3d 1068, 1072, 30 USPQ2d 1377, 1379 (Fed. Cir. 1994) ("When the patented invention is made by combining known components to achieve a new system, **the prior art must provide a suggestion or motivation to make such a combination.**") see *Crown Operations Int'l., Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002).

Closing

Applicants also believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.116 (4 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: 9 December 2002

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